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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,888	01/14/2002	Raymond F. Gesteland	T9479.B	5912
20450	7590	11/04/2004	EXAMINER	
ALAN J. HOWARTH P.O. BOX 1909 SANDY, UT 84091-1909			DEJONG, ERIC S	
			ART UNIT	PAPER NUMBER

1631

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/050,888	Applicant(s) GESTELAND ET AL.	
	Examiner Eric S. DeJong	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-43, drawn to methods of predicting antisense activity that involve constructing or developing an artificial neural network, mapping sequence motifs to selected RNA and obtaining an output of predicted antisense activity of a test oligonucleotide, classified in class 702, subclass 20. If this group is elected then the below summarized species elections are required.
- II. Claims 44-64, drawn to an artificial neural network embodied on a computer-readable media comprising an input layer of nodes, options for a hidden layer of nodes having full connectivity to input nodes, and an output layer of nodes, classified in class 702, subclass 19. If this group is elected then the below summarized species elections are required.

The inventions are distinct, each from the other because:

Inventions of Groups I and Group II are directed to methods and systems that can predict antisense activity of a test oligonucleotide by developing or constructing an artificial neural network. Group I is specific in requiring the construction of a database comprising sequence data of oligonucleotides that have been tested *in vivo* for the activity of down-regulating of RNA expression. The invention of Group II does not

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encompass the construction of such a database of sequence motifs, but rather only accommodates for the use of such a database. Further, the description of the artificial neural network provided for by Group II is such that it encompasses any artificial neural network comprising an input layer, optionally hidden layers and an output layer. The description which follows "wherein" in line 13 of claim 44 does not serve to structurally limit the invention. As such the artificial neural network of Group II is of a different composition and thus can be made from a materially different process than that provided for in Group I.

Because these inventions are distinct for the reasons given above and the search required for each Group involves separately described and published material, restriction for examination purposes as indicated is proper.

FIRST SPECIES ELECTION REGARDING GROUPS I and II

This application contains claims directed to the following patentably distinct species of the claimed invention:

The specie of data comprising the sequence database in claims 2, 23 and 45 is of distinct composition and described separately in literature thus demonstrating an undue burden if search together with along side of generic sequence database compositions. Applicants are to elect one of the following species of sequence data: (A) sequence data compiled from published result reports obtained from using at least ten oligonucleotides and at least one mismatch/scrambled control nucleotide or (B) an unspecified sequence data with respect to that listed above.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 3-22, 24- 43 (Group I); and 44 and 46-64 (Group II) are generic to the above listed species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

SECOND SPECIES ELECTION REGARDING GROUPS I and II

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species of input layer composition as set forth in claims 3-5, 24-26 and 46-48 are distinct from one another and are separately described and published in the literature demonstrating an undue burden if searched together. Applicants are to elect one of the following species of input layer composition: (C) an input layer comprising one input node per sequence motif, (D) an input layer comprising only sequence motifs exhibiting a statistical correlation in their presence to oligonucleotide activity, (E) a χ^2 test for significance is performed to rank the database of sequences and then input nodes are correlated to most significant ranked sequence motive, one node per sequence motif, (F) an unspecified input layer composition with respect to those listed above.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 6-23, 27-43 (Group I); and 44, 45 and 49-64 (Group II) are generic to the above listed species.

Species of χ^2 significance test performed on database sequences as set forth in claims 6, 7, 27, 28, 49 and 50 are distinct and separately described and published in literature thus demonstrating an undue burden if searched together. If applicants elect Specie (E) then applicants are to further elect one of the following species for the χ^2 significance test: (G) the selected number of most significant sequences is about 20 to about 80, (H) the selected number of most significant sequences is about 40 or (I) an unspecified number of most significant sequences with respect to those listed above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 5 and 26 (Group I) and 58 (Group II) are generic above listed species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

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all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

THIRD SPECIES ELECTION REGARDING GROUPS I and II

This application contains claims directed to the following patentably distinct species of the claimed invention:

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Species of hidden layer composition as set forth in claims 8, 9, 29, 30, 51 and 52 are distinct and separately described and published in literature thus demonstrating an undue burden if searched together. Applicants are to elect one of the following species of hidden layer composition: (J) at least one hidden layer comprising from about 4 to about 16 nodes (K) at least one hidden layer comprising about 4 nodes (L) at least one hidden layer comprising an unspecified number of nodes with respect to those listed above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-7, 10-28, 31-43 (Group I); and 44-50 and 53-64 (Group II) are generic to the above listed species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

FOURTH SPECIES ELECTION REGARDING GROUPS I and II

This application contains claims directed to the following patentably distinct species of the claimed invention:

The specie of output layer composition as set forth in claims 10, 31 and 53 is distinct and separately described and published in literature demonstrating an undue burden if searched together with a generic output layer composition. Applicants are to elect on of the following species of output layer composition: (M) output layer that

comprises one output node or (N) output layer that comprises an unspecified number of output nodes.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-9, 11-30, 32-43 (Group I); and 44-52 and 54-64 (Group II) are generic

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

FIFTH SPECIES ELECTION REGARDING GROUPS I and II

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species of methods for training the artificial neural network as set forth in claims 11, 12, 32, 33, 54 and 55 are distinct and separately described and published in literature demonstrating an undue burden if searched together. Applicants are to elect one of the following species of artificial neural network training methods: (O) use of a back-propagation algorithm with a momentum term, (P) use of a back-propagation algorithm without a moment term or (Q) use of an unspecified training algorithm with respect to those above listed.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is

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finally held to be allowable. Currently, claims 1-10, 13-31 and 34-43 (Group I); and 44-53 and 56-64 (Group II) are generic to the above listed species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

SIXTH SPECIES ELECTION REGARDING GROUPS I and II

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species of reporting and assessing predicted antisense activity as set forth in claims 13-16, 34-37 and 56-59 are distinct and separately described and published in literature demonstrating an undue burden if searched together. Applicants are to elect one of the following species of reporting and assessing predicted antisense activity: (R) by ROC analysis, (S) by minus 10% cross validation, (T) by take-one-out cross-validation, (U) by means of minus-one-RNA-validation or (V) by an unspecified method with respect to those listed above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-12, 17-33, 38-43 (Group I); and 44-55 and 60-64 (Group II) are generic to the above listed species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

SEVENTH SPECIES ELECTION REGARDING GROUPS I and II

This application contains claims directed to the following patentably distinct species of the claimed invention:

The specie of sequence motif count as set forth in claims 17, 38 and 60 is distinct and separately described and published in literature demonstrating an undue burden if searched together with a generic specie motif count. Applicants are to elect one of the following species of sequence motif count: (V) counts are entered as normalized data or (X) counts are entered as data in an unspecified manner with respect to that listed above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-16, 18-37, 39-43 (Group I); and 44-59 and 61-64 (Group II) are generic to the above listed species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

EIGHTH SPECIES ELECTION REGARDING GROUPS I and II

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species of discriminating antisense activity as set forth in claims 18, 19, 39, 40, 61 and 62 are distinct and separately described and published in literature

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demonstrating an undue burden if searched together. Applicants are to elect one of the following species of discriminating antisense activity: (Y) low-activity oligonucleotides are emphasized and high-activity oligonucleotides are de-emphasized, (Z) oligonucleotide antisense activity data is entered using a binary threshold function with a cutoff in the range of about 0.01-0.50 or (AA) an unspecified discrimination method with respect to those listed above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-17, 20-38, and 41-43 (Group I); and 44-60, 63 and 64 (Group II) are generic to the above listed species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

NINTH SPECIES ELECTION REGARDING GROUPS I and II

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species of combining the predicted antisense activity of the artificial neural network with other systems as set forth in claims 20, 21, 41, 42, 63 and 64 are distinct and separately described and published in literature demonstrating an undue burden if searched together. Applicants are to elect one of the following species of combining predicted antisense activity of the neural network : (BB) combination with a predicted antisense activity of at least one other artificial neural network, (CC) combination with

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an estimator of free energy associated with oligonucleotide-RNA duplex creation, (DD) a combination with both a a predicted antisense activity of at least one other artificial neural network and with an estimator of free energy associated with oligonucleotide-RNA duplex creation or (EE) a combination with an unspecified system with respect to those listed above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-19, 22-40 and 43 (Group I); and 44-62 (Group II) are generic to the above listed species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric S. DeJong whose telephone number is (571) 272-6099. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDJ



 11/2/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER